

information of the box number corresponding to the bulletin board box and a telephone number of the calling side.

21. (Amended) The facsimile device according to claim 19, wherein the image transfer device transfers the second image data stored in the specified memory box to the calling side when the judgement device judges that the identification number assigned to the confidential box does not coincide with the identification number included in the transfer command.

23. (Amended) The facsimile device according to claim 15, wherein the second image data includes at least a method of specifying the box number and the identification number.

25. (Amended) The facsimile device according to claim 15, wherein the specified memory box is set to one of the bulletin board boxes.

31. (Amended) The facsimile device according to claim 26, wherein the transfer command includes information of the box number and the identification number corresponding to the confidential box and a telephone number of the calling side, and information of the box number corresponding to the bulletin board box and a telephone number of the calling side.

#### REMARKS

By this Amendment, claims 4, 5, 17, 18, 20 and 30 are canceled without prejudice or disclaimer, and claims 1, 6, 12, 19, 21, 23, 25 and 31 are amended. Accordingly, claims 1-3, 6-16, 19, 21-29 and 31-46 are pending. No new matter is added. Claims 38-46 have previously been withdrawn from consideration.

The attached Appendix includes marked-up copies of each rewritten claim (37 C.F.R. §1.121(c)(1)(ii)).

Entry of the amendments is proper under 37 CFR §1.116 since the amendments:  
(a) place the application in condition for allowance for the reasons discussed herein; (b) do

not raise any new issue requiring further search and/or consideration since the amendments merely cancel claims and incorporate the subject matter of dependent claims into an independent claims; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Reconsideration of the application in view of the foregoing is respectfully requested.

Applicants gratefully acknowledge that the Office Action indicates that claims 9 and 10 include allowable subject matter.

**I. Certified Copies of the Priority Documents**

Both the March 19, 2002 and December 3, 2002 Office Actions' summaries do not indicate that the certified copies of the priority documents are received. However, Applicants submitted a Claim for Priority and certified copies of Japanese Patent Application Nos. 10-018788, 10-018806, 10-018824, 10-100063 and 10-100064 on January 27, 1999. Acknowledgment of receipt of the certified copies is respectfully requested.

**II. Acknowledgement of References Cited in IDS**

The March 19 Office Action attaches a copy of Form PTO-1449 from the IDS filed January 27, 1999 submitting a copy of JP-A-8-168009. However, the Examiner has failed to initial or draw a line through the citation indicating whether or not the reference is considered.

The Examiner is requested to initial the attached copy and return to confirm consideration of JP-A-8-168009. The relevance of this reference is discussed on pages 2-4 of the present application. For the Examiner's convenience, a copy of the PTO-1449 is attached.

### III. The Claims Define Allowable Subject Matter

The Office Action rejects claims 1-8 and 11-37 under 35 U.S.C. §103(a) over U.S. Patent No. 5,452,099 to Von Meister. The rejection is moot with respect to canceled claims 4, 5, 17, 18, 20 and 30 and is respectfully traversed with respect to the remaining claims.

Claim 1 is amended to include the features of claims 4 and 5.

With respect to original claims 4 and 5, the Office Action asserts that "Von Meister further teaches that the memory box includes a plurality of confidential boxes and non-confidential boxes wherein each of the confidential boxes is accompanied with the box number and an identification number while the non-confidential boxes is accompanied with only the box number. However, Von Meister does not disclose these features now recited in independent claim 1.

Further, the Office Action fails to show support for the rejection of claims 4 and 5. Specifically, the Office Action has not cited any specific structure in Von Meister of the features found in original claims 4 and 5. Thus, the Office Action has not established a *prima facie* case of obviousness.

MPEP §2143.03 instructs that "[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

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Instead, the mask memory storage unit 25 of Von Meister functions only to sequentially store facsimile information received through the data network 23 and the data line 24. Additionally, Von Meister does not inherently include any concept of providing a plurality of memory boxes, each assigned a previously determined box number. Therefore, Von Meister does not teach or suggest the confidential boxes and the bulletin board boxes recited in claim 1.

Therefore, it is respectfully submitted that claim 1 is patentable over Von Meister. Further, it is respectfully submitted that claims 2-3, 6-8, 11-16, 19, 21-29 and 31-37 are

patentable at least in view of the patentability of claim 1 from which they depend, as well as for the additional features they recite.

Accordingly, withdrawal of the rejection is respectfully requested.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3, 6-16, 19, 21-29 and 31-46 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:JML/vgp

**Attachments:**

Appendix  
Petition for Extension of Time  
Copy of Form PTO-1449

Date: May 5, 2003

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